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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Yukihiro Abiko

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EXAMINER

NGUYEN, HUY THANH

ART UNIT

PAPER NUMBER

2621

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/816,370

Applicant(s)

ABIKO ET AL.

Examiner

HUY T. NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 4-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01 August 2006 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1,4-5,7-11, 13, 16-17 ,19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Hibi et al (5,546,191).

Regarding claims 1, 7-9 and 19, Hibi discloses a video recording and reproducing apparatus (Figs.21, column 31, line 40 to column 35 comprising:

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a recording means (77) for recording the images

randomly accessible data storage means (79) for storing the images recorded in said image recording means (column 14, line 62 to column 15, line 37);

image display means for displaying in one screen a plurality of images read out from said data storage means (Fig. 16 column 24, lines 50-65) ; and

information processing means (95) for controlling said data storage means and said image displaying means ,wherein said information processing mean controls said data storage means and said image displaying means in such a manner that a plurality of images recorded in said image recording means at different time points are read from said data storage means and displayed in a single screen ( Fig. 16) ; and

an interface means for selecting one of a rapid speed and a pause and for searching the content (column 32, lines 22-27).

Method claim 13 corresponds to apparatus claim 1. Therefore, method claim 13 is rejected by the same reason as applied to apparatus claim 1.

Further for claim 13, Hibi further teaches a medium for storing a program comprising the steps recited in the claim since Hibi teaches reproducing and displaying the images are executed and controlled by a controller (Fig. 16 and 27, column 31, line 41 to column 32, line 40)

Regarding claims 4,10,16 and 20, Hibi further teaches the user interface means interposed between said information processing means and the user, wherein a plurality of the image contents stored in said data storage means are converted into a data base

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capable of being searched and sorted, and at least one of the image contents included in a group of image contents searched for and sorted from said data base (column 24, lines 40-60, column 32, lines 1-40) , and synthesizing the changed image contents with the image content at the same time and is displayed in a single screen in accordance with the information input from said user interface means (Fig. 16).

Regarding claims 5,11,17 and 21 , Hibi further teaches wherein the image contents selected through said user interface means are changed to other image contents and the resulting image contents are displayed in a single screen by being synthesized with the image contents under generation (Fig. 16, column 24, lines 40-60).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1,4-5,7 ,10-11 ,13 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu et al (6,311,013) in view of Hirayama et al (5,630,006).

Regarding claim 1, Shimizu discloses a video recording and reproducing apparatus (Figs. 8, 10) comprising:

randomly accessible data storage means for storing the images recorded in said image recording means (column 14, line 62 to column 15, line 37);

image synthesizing means (mixing means) for synthesizing in one screen a plurality of images read out from said data storage means (column 15 lines 1-22) ; and

information processing means (controller, Fig.8) for controlling said data storage means and said image synthesizing means ,wherein said information processing mean; controls said data storage means and said image synthesizing means in such a manner that a plurality of images recorded in said image recording means at different time points are read from said data storage means and synthesized and displayed in a single screen (Figs 12 and 13).

Shimizu fails to specifically teach that the apparatus further comprising a recording means for recording the video input. However, it is noted that provide a recording for a recording/ reproducing apparatus is well known in the art as taught by

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Hirayama (Fig. 1, column 4). Therefore, it would have been obvious to one of ordinary skill in the art to modify Nakamura with Hirayama by providing the apparatus of Nakamura with a recording means as taught by Hirayama thereby enhancing the function of the apparatus of Nakamura and provide more convenience to the user in selecting a desired video program.

Method claim 7 and 13 correspond to apparatus claim 1. Therefore, method claims 7 and 13 are rejected by the same reason as applied to apparatus claim 1.

Applicant argues that Shimizu fails to teach the claimed invention since Shimizu teaches decoding the images of different angles at the same time. In response it is noted that the applicant's argument does not reflect the claims since the claims recite that the images are recorded at different time points, not decoding images at different time points as argued by applicant. Since the images of Shimizu are recorded on the medium in a time base (sequential recording from a start to an end of recording) the images of each angle are recorded at time points different from one to another.

Further for claim 13, Shimizu as modified with Hirayama further teaches a medium for storing a program comprising the steps recited in the claim since Shimizu teaches reproducing and synthesizing the images are executed and controlled by a controller (Fig. 8).

Regarding claims 4, 10 and 16, Shimizu as modified with Hirayama further teaches Nakamura further teaches user interface means interposed between said information processing means and the user, wherein a plurality of the image contents

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stored in said data storage means are converted into a data base capable of being searched and sorted, and at least one of the image contents included in a group of image contents searched for and sorted from said data base (column 10, lines 50-68, column 16, line 50 to column 17, line 5) , and synthesizing the changed image contents with the image content at the same time and is displayed in a single screen in accordance with the information input from said user interface means (See Hirayama (Figs 4-6,, column 6, lines 15-55).

Regarding claims 5,11 and 17 , Shimizu as modified with Hirayama further teaches wherein the image contents selected through said user interface means are changed to other image contents and the resulting image contents are displayed in a single screen by being synthesized with the image contents under generation (See Hirayama column 6, line s 20-42, Fig. 5).

6. Claims 1 ,6-9, 12-15 ,18 - 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura et al (5,970,205) in view of Yonemitsu (5,592,450).

Regarding claims 1 and 19, Nakamura discloses a video recording and reproducing apparatus comprising:

randomly accessible data storage means ( video RAM 43) for storing the images recorded in said image recording means (column 14, lines 8-25);

image synthesizing means for synthesizing in one screen a plurality of images read out from said data storage means (Fig. 12, column 14, lines 1-41) ; and



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information processing means for controlling said data storage means and said image synthesizing means;

wherein said information processing mean; controls said data storage means and said image synthesizing means in such a manner that a plurality of images recorded in said image recording means at different time points are read from said data storage means and synthesized and displayed in a single screen 1 said image synthesizing means (Figs 12 and 13 .

Further for claim 19, Nakamura further teaches a user interface means interposed between said information processing means and the user, wherein the special reproduction functions including at least selected one of rapid feed and pause are performed on the image contents selected arbitrarily through said user interface means (column 15, lines 40-55 using FF key, RF key or pause key) .

Nakamura fails to specifically teach that the apparatus further comprising a recording means for recording the video input. However, it is noted that provide a recording for a recording/ reproducing apparatus is well known in the art as taught by Yonemitsu et al (Figs. 1,32, columns 29, and 30). Therefore , it would have been obvious to one of ordinary skill in the art to modify Nakamura with Yonemitsu by providing the apparatus of Nakamura with a recording mean as taught by Yonemitsu thereby enhancing the function of the apparatus of Nakamura and provide more convenience to the user in selecting a desired video program .

Applicant argues that there is no motivation to combine Nakamura (reference discloses a apparatus for reproducing the images from a medium with Yonemitsu (reference teaches a recording and reproducing apparatus for recording and reproducing the images on and from a medium) . In response, the examiner disagrees. It is noted that the motivation is taught by Yonemitsu. Yonemitsu teaches a apparatus having a combination of recording operation and reproducing operation on that provide more convenience to the user in selecting and preserving desired image signal s for later viewing . Further it is noted that recording the images t preserved desired images for later viewing is well recognized in the art at the time the invention was made .

Method claims 7 and 13 correspond to apparatus claim 1. Therefoe method claims 7 and 13 are rejected by the same reason as applied to apparatus claim 1.

Further for claim 13, Nakamura as modified with Yonemitsu further teaches a medium for storing a program comprising the steps recited in the claim since Nakamura teaches reproducing and synthesizing the images are executed and controlled by a controller (Fig. 1).

Regarding claims 8 and 14, Nakamura further teaches a plurality of said image recorded at different time points are a plurality of image contents recorded at different time points or a plurality of images recorded at different time points for a given one image content (Figs. 12-13, column 16).

Regarding claims 9 and 15, Nakamura further teaches a user interface means interposed between said information processing means and the user, wherein the

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special reproduction functions including at least selected one of rapid feed and pause are performed on the image contents selected arbitrarily through said user interface means (column 15, lines 40-55 using FF key, RF key or pause key) .

Regarding claims 6,12, 18 and 22, Nakamura further teaches user interface means interposed between said information processing means and the user, wherein said sound select means outputs only the sound corresponding to the image contents reproduced in the reproduction display area selected by said user interface means (column 17, lines 35-65).

7. Claims 4,5,10,11 , 16-17, 20 –21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura et al (5,970,205) in view of Yonemitsu (5,592,450) as applied to claims 1,7 and 13 above , further in view of Akiha et al ( 6,377,745).

Regarding claims 4,10 ,16 and 20, Nakamura further teaches user interface means interposed between said information processing means and the user, wherein a plurality of the image contents stored in said data storage means are converted into a data base capable of being searched and sorted, and at least one of the image contents included in a group of image contents searched for and sorted from said data base (column 10, lines 50-68, column 16, line 50 to column 17, line 5) , but fails to teach reproducing and synthesizing the changed image contents with the image content at the same time and is displayed in a single screen in accordance with the information input from said user interface means .

Akiha teaches a reproducing apparatus having a control means for displaying the images of different time point and changing the image content when an image is selected and displayed the changed image content the same time with the image contents (column 9, lines 40-55, Fig. 7). Therefore, it would have been obvious to one of ordinary skill in the art to modify Nakamura with Akiha by providing the apparatus Nakamura with a control means as taught by Akiha thereby providing more convenience to the user in selecting a scene or portion of a video program for viewing.

Regarding claims 5, 11, 17 and 21, Nakamura fails to teach means for wherein the image contents selected through said user interface means are changed to other image contents and the resulting image contents are displayed in a single screen by being synthesized with the image contents under generation.

Akiha teaches a reproducing apparatus having a control means for displaying the images of different time points and changing the image content when an image is selected (column 9, lines 40-55, Fig. 7). Therefore, it would have been obvious to one of ordinary skill in the art to modify Nakamura with Akiha by providing the apparatus Nakamura with a control means as taught by Akiha thereby providing more convenience to the user in selecting a scene or portion of a video program for viewing.

### **Conclusion**

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8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yeo, Steven and Akiba et al teaches apparatus or displaying images of different channels or portion of a video signal in a screen.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

H.N

  
HUY T. NGUYEN  
PRIMARY EXAMINER